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PATENT #12/BM
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In re Patent Application of
Thomas Gilchrist

Serial No.: 09/424,811

Filed: November 30, 1999

For: METHOD OF PRODUCING WATER-
SOLUBLE GLASS FIBRES

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Group Art Unit: 1731

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Examiner: J. Hoffmann

Commissioner for Patents
Washington, D.C. 20231

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SECOND INFORMATION DISCLOSURE STATEMENT

Sir:

This is a second information disclosure statement submitted under 37 C.F.R. 1.56, 1.97 and 1.98 again making of record two references that had previously come to the attention of applicant's counsel respecting to this application and had previously been submitted to the United States Patent and Trademark Office.

The two references are English language abstracts of Japanese patent publications. Copies are enclosed; the two references are listed on an attached Form PTO-1449 modified.

Based on the English language abstract of the first Japanese patent publication numbered 58,004,821, this reference apparently discloses a calcium phosphate fiber production process by extrusion through an air cooling nozzle and dipping in acid and is believed relevant to method for producing water soluble glass fibers which is the subject of the instant application.

Based on the English language abstract of the second Japanese patent publication numbered 48,042,814, this reference apparently discloses a crystal glass fiber having high heat strength and is believed to be relevant to the patentability of the method of producing water soluble glass fibers as set forth in the instant application.

No English translation of the full text of either of these two Japanese patent publications is readily available to applicant or applicants' counsel.

We respectfully request that these references be made of record in the instant applicant as having been considered on their merits in connection with the examination of the application.

Respectfully submitted,

Date: 13 February 2002



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CERTIFICATE OF MAILING
UNDER 37 C.F.R. 1.8

I hereby certify that this paper, along with any paper referred to as being attached or enclosed, is being deposited with the United States Postal Service, first class mail, under 37 C.F.R. 1.8, on the date indicated above, and is addressed to the U.S. Patent and Trademark Office, Washington, DC 20231.

By: Darlene Dickinson

Signature: 

Date: February 13, 2002



IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

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**SECOND REQUEST FOR RECONSIDERATION OF
TIMELY SUBMITTED INFORMATION DISCLOSURE STATEMENT
AND, TO THE EXTENT REQUIRED, CURATIVE
INFORMATION DISCLOSURE STATEMENT SUBMISSION**

Sir:

This is submitted in response to a Form PTO-1449 modified bearing a date stamp of 23 June 2000 which accompanied an official action bearing a mailing date of 29 May 2001, and is also submitted in response to two (2) paragraphs appearing at the close of the examiner's remarks in the official action dated 13 September 2001.

As background, applicants note that applicants submitted an information disclosure statement on 21 June 2000 making of record five (5) references that had come to the attention of applicants' counsel. Two of those references were English language abstracts of Japanese patent publications. In the information disclosure statement, applicants' counsel characterized each of the two (2) Japanese patent publications, of which the English language abstracts were submitted, on the basis of what applicants' English-speaking counsel could divine from those English language abstracts of the

Japanese language patent publications. Specifically, applicants' counsel noted that Japanese patent publication 58,004,821 "apparently discloses a calcium phosphate fiber production process by extrusion through an air cooling nozzle and dipping in acid and is believed relevant to a method for producing water soluble glass fibers which is the subject of the instant application." Respecting the second Japanese patent abstract, applicants' counsel noted that Japanese patent publication 48,042,814 apparently "discloses a crystal glass fiber having high heat strength and is believed to be relevant to the patentability of the method of producing water soluble glass fibers as set forth in the instant application."

Applicants' counsel went on to note that no English translation of the full text of either of the two Japanese patent publications was readily available to applicants or to applicants' counsel.

That information disclosure statement included a Form PTO-1449 modified, on which the five (5) references were listed.

A photocopy of the PTO-1449 modified form, bearing the examiner's initials accompanied the official action of 29 May 2001. On that photocopy as received the examiner had struck through the identifying information for both Japanese patent publications 58,004,821 and 48,042,814 and had written adjacent to the strike-out "no copy of patent".

In response to this, applicants submitted a request for reconsideration of the timely submitted information disclosure statement; that request was submitted on 19 June 2001, less than one-month after the mailing date of the 29 May 2001 official action. In the request for reconsideration, applicants noted that the relevance of the two Japanese

patent publications had already been discussed in the information disclosure statement and that counsel for the applicant had noted that no English translation of the full text of either of the Japanese patent publications was readily available and further that it was the understanding of applicant's counsel that the full text of the Japanese publications had not been furnished to the applicants in connection with the International Search Report for the Patent Cooperation Treaty patent application from which the instant application springs.

At that time, applicants requested reconsideration of the information disclosure statement and asserted that the Japanese patent publications identified in the information disclosure statement qualified as "publications" under 37 C.F.R. 1.98(a)(2)(ii) and that submission of the photocopy of the English language translation of each of the abstracts satisfied the requirement for submission of "that portion which caused (the references) to be listed" under 37 C.F.R. 1.98(a)(2)(ii).

Applicants subsequently submitted a supplement to the request for reconsideration of the timely submitted information disclosure statement, furnishing the United States Patent and Trademark Office with a Form PTO-1449 modified having the English language abstracts of the two (2) Japanese patent references listed in the section for "non patent documents". The supplement to the request for reconsideration of the timely submitted information disclosure statement further noted that copies of the abstracts had previously been submitted with the applicants' information disclosure statement dated 21 June 2000 and further noted that the submission of the Form PTO-1449 modified on which the English language abstracts of the two Japanese patent

publication documents were listed had been made in response to a suggestion by the examiner during a telephone conversation on 28 June 2001.

A photocopy of page two of the supplement to the request for reconsideration of the timely submitted information disclosure statement is submitted herewith where the substance of the telephone interview of 28 June 2001 is summarized.

In the closing of the supplement to the request for reconsideration of the timely submitted information disclosure statement, the applicants again respectfully requested consideration of the two English language abstracts of the two Japanese patent publications and further requested an indication of the same by the examiner initialing and returning a photocopy of the enclosed Form-1449 modified.

No such initialed copy of such Form PTO-1449 modified has been received.

After seeking to comply fully with the examiner's suggestion made on 28 June 2001 by submission of the supplement to the request for reconsideration of the timely submitted information disclosure statement, applicants were surprised and grossly disappointed at the examiner's apparent shift of position as set forth in the official action of 13 September 2001, in which the examiner stated if it were the case that the Japanese patents were not readily available, the examiner's view was there should be no mention of the patents on the PTOL-1449 Form. The examiner went on to state that the United States Patent and Trademark Office will not falsely represent to the public, or anyone, that a document was received and considered, if only an abstract was received and considered.

Applicants, of course, do not wish the United States Patent and Trademark Office to falsely represent anything to anyone. If the examiner's objection to the information

disclosure statement previously submitted is that the abstracts the Japanese patent publications should not have been characterized in the manner they were, applicants respectfully offer their apologies for any problem caused by the same. Applicants do submit that any such refusal to consider the information disclosure statement and the abstracts submitted therewith amounts to an overly technical application of the United States Patent and Trademark Office policies and overly technical application of the disclosure rules, namely 37 C.F.R. 1.97 and 1.98.

The supplemental request for reconsideration of the information disclosure statement contained a modified PTOL-1449 Form at the suggestion of the examiner. Having fully complied with the suggestion of the examiner, applicants now should not be penalized either financially or otherwise by a failure to consider the papers submitted heretofore, especially the two English language abstracts of the Japanese patent publications.


Out of an abundance of caution, there is submitted herewith a second information disclosure statement together with a PTOL-1449 Form having the two English language abstracts of the two Japanese patent publications listed thereon.

Applicants respectfully assert that with the submission of these materials having originally been made in a timely fashion, no fee should be required in connection with this second information disclosure statement, especially when this information disclosure statement has been occasioned by the examiner's reversal of his prior position regarding the supplemental request for reconsideration of the first information disclosure statement. Applicants respectfully request that the examiner consider the two English language abstracts of the Japanese patent publications that have previously been submitted and are

submitted in duplicate herewith and that the upon allowance of the application that the two English language abstracts be listed among the references cited in the course of consideration of the application. Applicants further request that no fee be charged in connection with this. To the extent a fee may be required, please charge the same to deposit account 50-1943.

Respectfully submitted,

Date: 13 February 2002



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